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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/828,754   | 04/09/2001  | Chung-Wei Wu         | DEE-PT016           | 6486             |
| 3624   | 7590        | 02/08/2005           | EXAMINER            |                  |
| VOLPE AND KOENIG, P.C.<br>UNITED PLAZA, SUITE 1600<br>30 SOUTH 17TH STREET<br>PHILADELPHIA, PA 19103 |             |                      | DEAN, RAYMOND S     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2684                |                  |

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/828,754             | WU, CHUNG-WEI       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Raymond S Dean         | 2684                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 November 2004.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1, 3, 5 - 7, 9 - 13 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1, 3, 5 - 7, 9 - 13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 22 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive.

Examiner respectfully disagrees with applicants' assertion on Page 6, 4<sup>th</sup> paragraph of the Remarks "The Applicant further submits that Pecen fails to teach or suggest ...". Pecen teaches a mobile phone (206) that is activated to communicate with others when said mobile phone receives a signal from the server device (200). The server device comprises a SIM card, which enables the mobile phone to be identified as a valid subscriber thus enabling said mobile phone to engage in wireless communication with others (See Figure 2, Column 1 lines 23 – 33, Column 3 lines 46 – 56).

Examiner respectfully disagrees with applicants' assertion on Page 7, 1<sup>st</sup> paragraph of the Remarks "Peters fails to teach or suggest this feature ...". Peters and Pecen both teach wireless devices that establish communication links via a Bluetooth protocol (See Pecen Column 3 lines 30 – 33 and Peters Column 6 lines 44 – 67). It is well established in the art that the Bluetooth protocol is a short-range wireless protocol in which the devices communicate with one another when said devices are a specific distance (10 meters according to the Bluetooth protocol) from one another.

Examiner agrees with applicants' assertion on Page 7, 2<sup>nd</sup> paragraph of the Remarks "Secondly, neither of the radio modems disclosed ...". Peters, however, does

teach wherein a first radio modem transmits a signal to a second radio modem when said first radio modem detects that the second radio modem is a specific distance away (See Column 6 lines 44 – 67). Peters teaches wherein a first device and second device communicate with one another when the second device is at a specific distance (10 meters according to the Bluetooth protocol) from the first device. Pecen, as set forth above, teaches an activation device (200) that transmits a signal to a mobile phone (206) that enables said mobile phone to engage in communications with others. Pecen (Column 3 lines 30 – 33) and Peters both teach wireless devices that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Bluetooth link taught in Peters as the local wireless link in Pecen for the purpose providing communication means to roaming mobile users as taught by Peters.

Examiner agrees with applicants' assertion on Page 8, 1<sup>st</sup> paragraph of the Remarks "Kennedy fails to teach or suggest a first device ...". Kennedy, however, does teach a Bluetooth enabled mobile phone that is used in a vehicle. Pecen in view of Peters and Kennedy teach mobile subscriber units that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the hands free device taught in Kennedy in the wireless system of Pecen in view of Peters for the purpose of enabling a user to operate the mobile subscriber unit hands free in a vehicle.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3, 5, and 9 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,466,804 B1) in view of Novak et al. (US 2003/0037020).

Regarding Claim 1, Pecen teaches a mobile phone configured to be contactlessly activated by a signal transmitted from an activation device located outside the mobile phone (Figure 2, Column 3 lines 46 – 56, the activation device is the server device (200), 206 is a mobile subscriber unit, a mobile phone is a mobile subscriber unit, the invention of Pecen eliminates the need for the mobile units to have SIM cards thus said mobile units are activated wirelessly by a remote SIM card), the activation device comprising an integrated circuit (IC) card (Figure 3A, SIM card (202) is the IC card), wherein the activation device automatically detects a distance between the activation device and the mobile phone, and when the mobile phone is a specific distance away from the activation device, the activation device transmits the signal (Column 3 lines 30 – 33, the mobile devices can communicate with server device via Bluetooth links, it is well established in the art that the Bluetooth protocol is a short-range wireless protocol in which the devices communicate with one another when said

devices are a specific distance (10 meters according to the Bluetooth protocol) from one another thus there will be a detection of said specific distance by the server device so that communications with the mobile devices can be established), the mobile phone comprising: an access module for receiving the signal transmitted from the activation device (Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206) communicates bi-directionally with the server device to access the remote SIM wirelessly thus there will be access module circuitry to enable access to said remote SIM) and an IC card driver for accessing, via the access module, data recorded in the IC card of the activation device (Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206) communicates with the server device to access the data recorded in the SIM, the mobile subscriber unit comprises integrated circuits, such as access module circuitry, that enable said mobile subscriber unit to communicate wirelessly with the server device to access the data recorded on the SIM thus there will be an IC card driver), the data for use by the mobile phone to establish a communication with others via a communication system when the access module receives the signal transmitted from the activation device (Figure 2, Column 1 lines 23 – 33, Column 3 lines 46 – 56, upon access of said remote SIM said mobile subscriber unit (206) will be activated and identified as a valid subscriber thus enabling said mobile phone to engage in wireless communication with others).

Pecen does not teach a database.

Novak teaches a database (Section 0026 lines 5 – 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the database structure taught by Novak in the SIM of Pecen for the purpose of storing the data contained in the SIM for future access as taught by Novak.

Regarding Claim 3, Pecen in view of Novak teaches all of the claimed limitations recited in Claim 1. Pecen further teaches wherein the IC card of the activation device records identification data configured to be recognized by the access module (Column 3 lines 46 – 56, a SIM card has identification data stored on said SIM card).

Regarding Claim 5, Pecen in view of Novak teaches all of the claimed limitations recited in Claim 1. Pecen further teaches an activation device that is carried on a user (Column 3 lines 39 – 42, the server device is a mobile unit thus it can be carried on a user) and the user is a specific distance away from the mobile phone, the communication system is activated by the activation device (Column 3 lines 30 – 33, Column 3 lines 46 – 56, the mobile devices can communicate with server device via Bluetooth links, it is well established in the art that the Bluetooth protocol is a short-range wireless protocol in which the devices communicate with one another when said devices are a specific distance (10 meters according to the Bluetooth protocol) from one another).

Regarding Claim 9, Pecen teaches an apparatus for establishing a communication comprising: a mobile phone comprising an access module (Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206), which is the mobile phone, communicates bi-directionally with the server device to access the remote SIM

wirelessly thus there will be access module circuitry to enable access to said remote SIM); and an integrated circuit (IC) card driver in communication with the access module (Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206) communicates with the server device to access the data recorded in the SIM, the mobile subscriber unit comprises integrated circuits, such as access module circuitry, that enable said mobile subscriber unit to communicate wirelessly with the server device to access the data recorded on the SIM thus there will be an IC card driver); and an activation device located outside the mobile phone (Figure 2, Column 3 lines 46 – 56, the activation device is the server device (200)), the activation device comprising: an IC card (Figure 3A, SIM card (202) is the IC card) wherein: the activation device automatically detects a distance between the activation device and the mobile phone; the activation device transmits an activation signal which contactlessly activates the mobile phone when the mobile phone is a specific distance away from the activation device (Column 3 lines 30 – 33, Column 3 lines 46 – 56 the mobile devices can communicate with server device via Bluetooth links, it is well established in the art that the Bluetooth protocol is a short-range wireless protocol in which the devices communicate with one another when said devices are a specific distance (10 meters according to the Bluetooth protocol) from one another thus there will be a detection of said specific distance by the server device so that communications with the mobile devices can be established, the invention of Pecen eliminates the need for the mobile units to have SIM cards thus said mobile units are activated wirelessly by a remote SIM card); the access module receives the signal transmitted from the activation device

(Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206) communicates bi-directionally with the server device to access, via the access module circuitry, the remote SIM wirelessly); and the IC card driver accesses, via the access module, data recorded in the IC card of the activation device (Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206) communicates with the server device to access the data recorded in the SIM, the mobile subscriber unit comprises integrated circuits, such as access module circuitry, that enable said mobile subscriber unit to communicate wirelessly with the server device to access the data recorded on the SIM), the data being for use by the mobile phone to establish a communication with others via a communication system when the access module receives the signal transmitted from the activation device (Figure 2, Column 1 lines 23 – 33, Column 3 lines 46 – 56, upon access of said remote SIM said mobile subscriber unit (206) will be activated and identified as a valid subscriber thus enabling said mobile phone to engage in wireless communication with others).

Pecen does not teach a database.

Novak teaches a database (Section 0026 lines 5 – 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the database structure taught by Novak in the SIM of Pecen for the purpose of storing the data contained in the SIM for future access as taught by Novak.

Regarding Claim 10, Pecen in view of Novak teaches all of the claimed limitations recited in Claim 9. Pecen further teaches wherein the IC card of the

activation device records identification data configured to be recognized by the access module (Column 3 lines 46 – 56, a SIM card has identification data stored on said SIM card).

Regarding Claim 11, Pecen in view of Novak teaches all of the claimed limitations recited in Claim 9. Pecen further teaches an activation device that is carried on a user (Column 3 lines 39 – 42, the server device is a mobile unit thus it can be carried on a user) and the user is a specific distance away from the mobile phone, the communication system is activated by the activation device (Column 3 lines 30 – 33, Column 3 lines 46 – 56, the mobile devices can communicate with server device via Bluetooth links, it is well established in the art that the Bluetooth protocol is a short-range wireless protocol in which the devices communicate with one another when said devices are a specific distance (10 meters according to the Bluetooth protocol) from one another).

4. Claims 6, 7, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,466,804 B1) in view of Novak et al. (US 2003/0037020), as applied to Claims 1, 9 above, and further in view of Kennedy et al. (US 6,377,825 B1).

Regarding Claims 6, 12, Pecen in view of Novak teaches all of the claimed limitations recited in Claims 1, 9. Pecen in view of Novak does not specifically teach a mobile phone that is used in a vehicle.

Kennedy teaches a mobile phone that is used in a vehicle (Abstract, Figure 1A, Column 5 lines 8 – 25).

Pecen in view of Novak and Kennedy teach mobile subscriber units that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the hands free device taught in Kennedy in the wireless system of Pecen in view of Novak for the purpose of enabling a user to operate the mobile subscriber unit hands free in a vehicle.

Regarding Claims 7, 13, Pecen in view of Novak and in further view of Kennedy teaches all of the claimed limitations recited in Claims 6, 12. Kennedy further teaches a mobile phone that is combined with an audio device in the vehicle (Figure 3, Figure 4A, Column 10 lines 34 – 57, the speakers are audio devices).

### ***Conclusion***

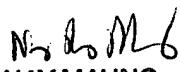
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S Dean whose telephone number is 703-305-8998. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raymond S. Dean  
January 26, 2005



NAY MAUNG  
SUPERVISORY PATENT EXAMINER